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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/015,951	12/17/2001	Mark J. Stefik	111325-88	5128
22204	7590	11/16/2005	EXAMINER	
NIXON PEABODY, LLP 401 9TH STREET, NW SUITE 900 WASHINGTON, DC 20004-2128			REAGAN, JAMES A	
			ART UNIT	PAPER NUMBER
			3621	

DATE MAILED: 11/16/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/015,951

Applicant(s)

STEFIK ET AL.

Examiner

James A. Reagan

Art Unit

3621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 27 January 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-34 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-34 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### **Status of Claims**

1. This action is in response to the amendment filed on 27 January 2005.
2. Claims 1, 11, 21, 26, 27, and 34 have been amended.
3. Claims 1-34 have been examined.
4. The rejections of claims 1-34 have been updated to reflect the amendments to the limitations.

### **Information Disclosure Statement**

5. The Information Disclosure Statement filed has been considered. An initialed copy of the Form 1449 is enclosed herewith.

## **RESPONSE TO ARGUMENTS**

6. Applicant's arguments received on 27 January 2005 have been fully considered but they are not persuasive. Referring to the previous Office action, Examiner has cited relevant portions of the references as a means to illustrate the systems as taught by the prior art. As a means of providing further clarification as to what is taught by the references used in the first Office action, Examiner has expanded the teachings for comprehensibility while maintaining the same grounds of rejection of the claims, except as noted above in the section labeled "Status of Claims." This information is intended to assist in illuminating the teachings of the references while providing evidence that establishes further support for the rejections of the claims.
7. Applicant's arguments with respect to claims have been considered but are moot in view of the new ground(s) of rejection.

**Claim Rejections - 35 USC § 103**

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 1-3, 6, 9, 10-14, and 21-34 rejected under 35 U.S.C. 103(a) as being unpatentable over Hartrick et al., (US 5,532,920 A) in view of HENRY H. PERRITT JR., Knowbots, "Permissions Headers and Contract Law Papers for the Conference on Technological Strategies for Protecting Intellectual Property in the Networked Multimedia Environment (30 April 2003).

**Claims 1-3, 6, 9, 11, 12, 14, 21, 27 and 28:**

Hartrick teaches a digital work distribution system comprising:

- *digital content representing a portion of a digital work rendered on a rendering device (see at least Figure 1, as well as other relevant and associated text);*
- *usage rights associated with said digital content, said usage rights expressed as statements from a usage rights language having a grammar defining a valid sequence of symbols and specifying a manner of use indicating one or more stated purposes for which the digital work can be used and distributed by an authorized party (see at least Figures 3A-7, as well as other relevant and associated text);*
- *storing the digital content and the usage rights as the digital work (see at least Figure 1, as well as other relevant and associated text);*

- *usage rights that further specify status information indicating the status of the digital work and a fee (revenue) type and parameter (e.g. best price fee) (see at least Figures 10 and 11, as well as other relevant and associated text )*
- *storing content and rights on the same device (see at least Figure 1; column 4, lines 40-53, as well as other relevant and associated text)*
- *usage rights that include state information indicating the extent of the manner of use exercised by an authorized user (see at least column 14, lines 15-50; column 15, lines 1-42, as well as other relevant and associated text);*

Hartrick does not specifically disclose *said usage rights expressed as statements from a usage rights language having a grammar defining a valid sequence of symbols and specifying a manner of use*. Perritt, However, in at least page 1 as well as other relevant text discloses, "...service identifiers and header descriptors and other forms of labeling and tagging appropriate to allow copyright owners to give different levels of permission, including outright transfer of the copyright interest, use permissions, copy permissions, distribution permission, display permission, and permission to prepare derivative works...how payment authorization procedures should work in conjunction with a permissions header..." It would have been obvious to one of ordinary skill in the art at the time of the invention to add Perritt's service identifiers and header descriptors and other forms of labeling for allowing copyright owners to give different levels of permission with Hartrick's Data processing system and method to enforce payment of royalties when copying softcopy books because the inclusion of Perritt's system goes beyond soft copy books and provides royalty enforcement for all types of digital media.

**Claims 10, 13, 29:**

Hartrick teaches that usage rights may be integrated within the text or in a separate file (see at least column 4, lines 45-50; column/line 4/66-5/5). Therefore, it would have been obvious to one of ordinary skill at the time the invention was made to store (e.g. floppy disk, CD-ROM) the

Art Unit: 3621

rights on a separate disk if additional space was needed because this type of design choice facilitates functionality of copy rights adherences.

**Claims 22-24, 26, 30-32 and 34:**

The combination of Hartrick/Perritt teaches a multimedia digital content distribution system as shown in the rejections above. Hartrick also discloses that users are charged fees for accessing content (see at least Figures 10 and 11, as well as other relevant text). Hartrick/Perritt do not specifically disclose:

- *the state information comprises information indicating the number of copies of the digital work that are in use;*
- *the state information comprises information indicating the number of time units for which the digital work can be used;*
- *the state information comprises information indicating the revenue owner of the digital work;*
- *the state information comprises information indicating the history of the use and distribution of the digital work;*

Perritt, However, in at least page 1 as well as other relevant text discloses, "...service identifiers and header descriptors and other forms of labeling and tagging appropriate to allow copyright owners to give different levels of permission, including outright transfer of the copyright interest, use permissions, copy permissions, distribution permission, display permission, and permission to prepare derivative works...how payment authorization procedures should work in conjunction with a permissions header..." It would have been obvious to one of ordinary skill in the art at the time of the invention to add Perritt's service identifiers and header descriptors and other forms of labeling for allowing copyright owners to give different levels of permission with Hartrick's Data processing system and method to enforce payment of royalties when copying softcopy books because the inclusion of Perritt's system goes beyond soft copy books and provides royalty enforcement for all types of digital media.

**Claims 25 and 33:**

Hartrick discloses storing book data such as author, title, copyright date and edition (see at least Figure 5 and associated text). Therefore, it would have been obvious to store other bibliographic data such as publisher and publication date because these data fields are also authoring and publishing data.

10. Claims 4, 5, 7, 8, 15, 16-20, are rejected under 35 U.S.C. 103(a) as being unpatentable over Hartrick/Perritt in view of Sprague et al., (US 5,247,575 A).

**Claims 4, 5, 7, 8, and 15-20:**

The combination of Hartrick/Perritt teaches a multimedia digital content distribution system as shown in the rejections above. Hartrick also discloses that users are charged fees for accessing content (see at least Figures 10 and 11, as well as other relevant text). Hartrick/Perritt do not specifically recite fees based on time. Sprague, however, teaches a digital content distribution system (see at least abstract; column 24, lines 9-16) where users are charged based on the type or class of content, time or subscription (column 4, lines 8-56; column 13, lines 24-59). Sprague also teaches maintaining a database that stores user fee, account and other statistical information (e.g. usage) (column/line 19/63-20/18; column 23, lines 47-66), as well as fee tables, or schedules and authorized users (column 22, lines 59-66; column 23, lines 46-65). Schedules, fee or tables are familiar and widely used. Similarly, "mark-up" prices are also standard techniques known to those of ordinary skill in retail. Therefore, it would have been obvious to one of ordinary skill to combine the teachings of Hartrick et al. and Sprague et al. in order to allow users the opportunity to select an access method (e.g. rent, purchase, subscription) that best meets their needs.

**Conclusion**

11. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).
12. A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.



Art Unit: 3621

Any inquiry of a general nature or relating to the status of this application or concerning this communication or earlier communications from the Examiner should be directed to **James A. Reagan** whose telephone number is **571.272.6710**. The Examiner can normally be reached on Monday-Friday, 9:30am-5:00pm. If attempts to reach the examiner by telephone are unsuccessful, the Examiner's supervisor, **James Trammell** can be reached at **571.272.6712**.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://portal.uspto.gov/external/portal/pair> . Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at **866.217.9197** (toll-free).

Any response to this action should be mailed to:

**Commissioner of Patents and Trademarks**

**Washington, D.C. 20231**

or faxed to:

**571-273-8300** [Official communications, After Final communications labeled "Box AF"]

**571-273-8300** [Informal/Draft communications, labeled "PROPOSED" or "DRAFT"]

Hand delivered responses should be brought to the **United States Patent and Trademark Office Customer Service Window**:

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**JAMES A. REAGAN**

Primary Examiner

Art Unit 3621

12 October 2005

A handwritten signature in black ink, appearing to read 'J. Reagan', with a long horizontal flourish extending to the right.